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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,217	03/25/2005	Takao Aichi	00862.023326	2027
5514	7590	10/02/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WHIPKEY, JASON T	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/529,217

Applicant(s)

AICHI ET AL.

Examiner

Jason T. Whipkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 11 is objected to because of an informality. An extraneous period is present on line 2. Appropriate correction is required.
2. Claim 28 is objected to because of an informality. The examiner suspects that the claim should read, "first recording condition is *designated by* a DPOF file." Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 31-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's

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functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See In re Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

An example of language in compliance with 35 U.S.C. 101 would be, "A computer readable recording medium encoded with a computer program for implementing a recording control method of claim 17."

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7-12, 15-20, 23-25, 27, and 29-33 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by Ogiwara (U.S. Patent Application Publication No 2003/0095160).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding **claims 1, 9, 17, 25, and 29**, Ogiwara discloses a recording system in which an image supply device (digital camera DC in Figure 4) and a recording apparatus (printer 1) directly communicate with each other, and data is supplied from said image supply device to said recording apparatus to attain a recording process (see paragraph 51), wherein said image supply device comprises:

an interface (the unlabeled bus shown in Figure 5) adapted to connect with a storage medium (image recording medium 56) which stores image data (see paragraph 54) and a first recording condition (the size of an image; see paragraph 58) associated with a recording process of the image data (an image must inherently be sized to fit on a piece of paper when printed);

acquisition means (the size of recording paper is received from the printer; see paragraph 58) for acquiring information associated with a function (printing on a piece of paper at an appropriate size) of said recording apparatus by communicating with said recording apparatus;

setting means (CPU 52) for setting a second recording condition (the enlargement or reduction of the original image necessary to fit on the paper; see paragraphs 58-59) associated with the recording process of the image data on the

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basis of the information associated with the function, which is acquired by said acquisition means; and

recording instruction means (CPU 52) for issuing a recording instruction to said recording apparatus on the basis of the first and second recording conditions (see paragraph 66), and

said recording apparatus comprises:

recording control means (inherently present in order to carry out the operations shown in Figure 2) for controlling to acquire image data stored in said storage medium in accordance with the recording conditions designated by said recording instruction means and to record the image data.

Regarding **claims 2, 10, and 18**, Ogiwara discloses:

said image supply device further comprises selection means (CPU 52) for selecting one of the first and second recording conditions to be preferentially used to issue a recording instruction to said recording apparatus (the CPU determines whether the aspect ratio is sufficient to print as-is or whether the image must be cropped to fit on the paper; see paragraphs 58-68).

Regarding **claims 3, 11, and 19**, Ogiwara discloses said image supply device further comprises:

comparison means (CPU 52) for comparing the first and second recording conditions (see paragraphs 58-63); and

recording condition selection means for, when it is determined as a result of comparison by said comparison means that the first and second recording

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conditions are different from each other, selecting one of the first and second recording conditions (the CPU determines whether the aspect ratio is sufficient to print as-is or whether the image must be cropped to fit on the paper; see paragraphs 58-68).

Regarding **claims 4, 12, and 20**, Ogiwara discloses said image supply device further comprises:

comparison means (CPU 52) for comparing the first and second recording conditions (see paragraphs 58-63); and

warning display means (display 57) for, when it is determined as a result of comparison by said comparison means that the first and second recording conditions are different from each other, displaying a warning (Figure 6 shows non-print areas that warn a user what will be cropped in order to fit the image on the paper; see paragraphs 60-62).

Regarding **claims 7, 15, and 23**, Ogiwara discloses:

said recording instruction means generates a command sequence for the second recording condition (see paragraph 48), which includes image data selected by the first recording condition in the second recording condition (see paragraphs 58-68).

Regarding **claims 8, 16, and 24**, Ogiwara discloses:

the second recording condition is a recording condition based on a common protocol between said image supply device and said recording apparatus

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(the camera is capable of requesting — and the printer is capable of sending — the current paper size; see paragraph 58).

Regarding **claims 27 and 30**, Ogiwara discloses a recording apparatus (the printer 1 shown in Figure 4) comprising:

transmission means for transmitting information relating to the functions of the recording apparatus to an image supply device (the printer is capable of sending the current paper size upon request; see paragraph 58); and

reception means for receiving information to designate a first recording condition (an original image size; see paragraph 58) which the image supply device has, wherein the information is designated by a second recording condition (the size of the paper in the printer) in accordance with the information relating to the functions of the recording apparatus (the printer receives image data of a first size after it has been resized and cropped in order to print on paper of the transmitted size; see paragraphs 58-68),

wherein the information to designate the first recording condition is described as image data to be recorded in the second recording condition (the printer receives image data of a first size after it has been resized and cropped in order to print on paper of the transmitted size; see paragraphs 58-68).

**Claims 31-33** may be treated like claims 17, 29, and 30, respectively. Additionally, Ogiwara teaches that camera executes a program stored on a RAM or ROM (see paragraph 69).



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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 5, 6, 13, 14, 21, 22, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogiwara in view of Cavill (U.S. Patent No. 6,982,800).

**Claims 5, 13, 21, 26, and 28** may be treated like claims 1, 9, 17, 25, and 27, respectively.

However, Ogiwara is silent with regard to using a DPOF.

Cavill discloses:

the first recording condition (such as image scaling; see column 5, lines 34-37) is designated by a DPOF (see column 5, lines 45-48).

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As stated in column 5, lines 45-48, an advantage of using the DPOF format is that a plurality of instructions may be transmitted to a printer using a known format. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Ogiwara's system incorporate the DPOF format for transmitting printer data.

Regarding **claims 6, 14, and 22**, Cavill discloses:

said image supply device (which sends the DPOF file with the photographs 21; see column 5, lines 45-48) comprises input means for inputting the first recording condition, and means for generating the DPOF on the basis of information input by said input means (see *id.*).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava, can be reached at (571) 272-7304. The fax phone number for the organization where this application is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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September 18, 2006



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